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OFFICE OF PETITIONS

In re Patent No. 7,094,874 : DECISION ON REQUEST
Peach et al. : FOR RECONSIDERATION OF
Issue Date: August 22, 2006 : PATENT TERM ADJUSTMENT
Application No. 09/865,321 : and
Filed: May 23, 2001 : NOTICE OF INTENT TO ISSUE
Atty Docket No. D0028PNP; : CERTIFICATE OF CORRECTION
30436.57USU1 :

This is a decision on the "APPLICATION TO CORRECT PATENT TERM ADJUSTMENT PERIOD IN GRANTED PATENT UNDER 37 C.F.R. §§ 1.181 & 1.705" filed October 20, 2006, which is properly treated pursuant to 37 CFR 1.705(d). Patentees request that the revised Patent Term Adjustment shown on the above captioned patent be corrected from two hundred fifty-three (253) days to three hundred sixty-five (365) days.

The request for reconsideration of the patent term adjustment indicated in the patent is GRANTED to the extent indicated herein.

Patentees are given TWO (2) MONTHS from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

For the reasons stated herein, the patent term adjustment indicated in the patent is to be corrected by issuance of a

certificate of correction showing a revised Patent Term Adjustment of **ONE HUNDRED EIGHTY (180)** days.

On August 22, 2006, the above-identified application matured into U.S. Patent No. 7,094,874. The instant request for reconsideration filed October 20, 2006 was timely filed within 2 months of the date the patent issued. See § 1.705(d). The Patent issued with a revised Patent Term Adjustment of 253 days. Patentees dispute the reductions, pursuant to 37 CFR 1.704(c)(10), of 8, 29, and 75 days respectively for the filing of a supplemental Application Data Sheet (ADS) on April 20, 2006, Drawings on May 11, 2006 and Drawings on June 9, 2006. Patentees do not dispute that these papers were filed after the mailing of the notice of allowance. Rather, patentees argue that: The Office improperly charged Applicants with 8 days of delay for filing a supplemental ADS that the Office itself requested. The Office erroneously charged Applicants with 29 days of delay for filing a first corrected drawing, when Applicants had no warning before the Notice of Allowance that corrected drawings would be necessary. The Office incorrectly charged Applicants with 75 days of delay for filing a second set of corrected drawings, again when Applicants had no warning before the Notice of Allowance that corrected drawings would be necessary.

Patentees' arguments have been considered. With respect to the reductions associated with the filing of drawings after the mailing of the notice of allowance, patentees' arguments are not persuasive. Patentees acknowledge submitting drawings after the mailing of the notice of allowance. Patentees are advised that the filing of drawings after the mailing of a notice of allowance is properly a basis for reduction of patent term adjustment.

37 CFR § 1.704(c)(10) provides that:

Submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

- (i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in

response to the amendment under § 1.312 or such other paper;

or

(ii) Four months;

In this instance, it is undisputed that the drawings were filed after the mailing of the notice of allowance. Accordingly, pursuant to § 1.704(c)(10), the patent term adjustment was properly reduced by 29 days for the drawings filed May 11, 2006 (for the period beginning on May 11, 2006 and ending on June 8, 2006, the day before further drawings were filed) and by 75 days for the drawings filed June 9, 2006 (for the period beginning on June 9, 2006 to the issuance of the patent on August 22, 2006). (The first period ended on June 8, 2006 so as not to overlap with the second period of reduction for drawings).

As stated in MPEP 2732, by Notice entitled Clarification of 37 CFR 1.704(c)(10) - Reduction of Patent Term Adjustment for Certain Types of Papers Filed After a Notice of Allowance, 1247 OG 111 (June 26, 2001), the Director set forth examples of papers deemed not to cause substantial interference and delay in the patent issue process. A submission of drawings was not identified in the Notice. Other than those papers identified in this Notice, all papers filed after allowance of an application substantially delay the Office's ability to process an application for a patent because the Office does not wait until payment of the Issue Fee to begin the patent issue process. As a result, 37 CFR 1.704(c)(10) does not distinguish between papers that are and are not required by the Office. Filing of any drawings after allowance will be treated as a failure to engage in reasonable efforts to conclude prosecution.

Furthermore, it is noted that corrected drawings were required because the drawings originally filed by applicants were inconsistent with their own Brief Description of Drawings. Thus, applicants did not have to wait until the mailing of a notice to be aware of and take action to correct this inconsistency. Further, the second filing of drawings after the mailing of the notice of allowance was required because of the quality of the earlier filed set of drawings filed. The drawings filed June 9, 2006 are of a better quality than the drawings previously-filed. Applicants were not precluded from submitting better quality drawings earlier.

However, with respect to the reduction of 8 days associated with the supplemental ADS filed April 20, 2006, Patentees' contention is well taken. The record supports a conclusion that by amendment filed March 3, 2003, the requested correction to the priority claim was entered in the application. This was well before the mailing of the notice of allowance on March 21, 2006. At the request of the examiner, this information was resubmitted in the form of a supplemental ADS on April 20, 2006. It is not controlling that the ADS was requested by the examiner. Rather, given that the ADS was, in effect, a resubmission of a previously-filed paper and under the circumstances of this case, it is appropriate to treat the ADS for purposes of PTA calculation as submitted by way of an amendment on March 3, 2003, prior to the mailing of the notice of allowance on March 21, 2006. Thus, the resubmission of the amendment by way of an ADS on April 20, 2006 did not constitute a failure to engage within the meaning of 37 CFR 1.704(c)(10). The reduction of 8 days is removed.

However, the review of the reduction reveals a further basis for entry of a period of reduction. Specifically, on October 24, 2005, applicants filed a Request for Continued Examination and an amendment. By Notice mailed November 14, 2005, applicants were advised of an omission in this response. On January 13, 2006, applicants filed a response correcting the omission. 37 CFR 1.704(c)(7) provides that "Submission of a reply having an omission (§1.135(c)), " is a "failure to engage" and that "the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the reply having an omission was filed and ending on the date that the reply or other paper correcting the omission was filed." Accordingly, pursuant to this section, a period of reduction of 81 days is being entered for the period from October 25, 2005 to January 13, 2006.

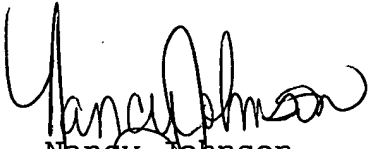
In view thereof, the patent term adjustment indicated on the patent should be one hundred eighty (180) days.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a

certificate of correction indicating that the term of the above-identified patent is extended or adjusted by ONE HUNDRED EIGHTY (180) days.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.

A handwritten signature in black ink, appearing to read "Nancy Johnson", written over the printed name.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,094,874 B2

DATED : August 22, 2006

INVENTOR(S) : Peach et al.

DRAFT

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (253) days

Delete the phrase "by 253" and insert – by 180 days--